REMARKS/ARGUMENTS

The Examiner is thanked for the performance of a thorough search.

By this amendment, Claims 1, 3, and 4 are amended, Claims 14, 16-26 are canceled, and Claims 27-38 are added. Hence, Claims 1, 3-13, and 27-38 are pending in the application.

I.   SUMMARY OF THE REJECTIONS

Claims 14 and 16-26 stand rejected under 35 U.S.C. § 101 as allegedly being directed to non-statutory subject matter. Claims 14 and 16-26 are canceled which renders this rejection moot. However, Claims 27-38 are added in place of Claims 14 and 16-26. Claims 27-38 are directed towards a one or more **storage** media. The arguments of the Office Action seem to suggest that Claims 14 and 16-26 were directed towards carrier waves. However, the plain meaning of "one or more storage media storing instructions" requires that the storage media *store* the instructions so that they may be executed by one or more computer processors. A carrier is not a storage medium because a carrier wave is not a medium that is capable of storing instructions that may be executed by a computer processor. While it is true that a carrier may *carry* instructions, those instructions carried by a carrier wave are not *stored*. For example, volatile or non-volatile memories may store instructions, whereas a carrier wave cannot. The Applicants acknowledge that the Patent Office's current position is that carrier waves are not patentable subject matter, but a storage medium is not a carrier wave.

The Patent Office has previously acknowledged that claims directed to a storage medium are patentable (see *In re Beauregard*). Even after the adoption of the current Interim Guidelines, the USPTO continues to issue many patents with claims directed towards storage media.

Further, a storage medium qualifies as an article of manufacture, which is expressly recognized as patentable subject matter under 35 U.S.C. § 101. Consequently, it is respectfully submitted that each of Claims 27-38 is directed towards statutory subject matter.

Claims 1, 3-8, 10, 11, and 13 stand rejected under 35 U.S.C. § 103(a) as allegedly being unpatentable over U.S. Patent No. 6,154,740 issued to Shah ("*Shah*") in view of U.S. Patent No. 6,272,484 issued to Martin et al. ("*Martin*"). This rejection is respectfully traversed.

Claims 9 and 22 stand rejected under 35 U.S.C. § 103(a) as allegedly being unpatentable over *Shah* in view of *Martin*, and further in view of U.S. Patent Publication No. 2002/0023004 to Hollander et al. ("*Hollander*"). This rejection is respectfully traversed.

Claims 12 and 25 stand rejected under 35 U.S.C. § 103(a) as allegedly being unpatentable over *Shah* in view of *Martin*. This rejection is respectfully traversed.

II.   THE REJECTIONS BASED ON THE CITED ART

Claims 1, 3-8, 10, 11, and 13 stand rejected under 35 U.S.C. § 103(a) as allegedly being unpatentable over *Shah* in view of *Martin*.

A.   CLAIM 1

Claim 1 recites:

> A method of depicting a plurality of items and how said plurality of items satisfy multiple criteria, the method comprising the computer-implemented steps of:
> a browser receiving a page; and
> **in response to executing said page, said browser performing the steps of:**
> > generating a display of a list of visual indicators in a particular order,
> > > wherein the particular order indicates how said plurality of items satisfy a first criteria;
> > **detecting input indicating the selection of a second criteria;**
> > **in response to detecting said input, determining, without said**
> > > **browser having to interact over a network with a server, how**
> > > **said plurality of items satisfy the second criteria; and**

> while retaining said list of visual indicators in said particular order within said display, **displaying a visual indication of how said plurality of items satisfy the second criteria.** (emphasis added)

The combination of *Shah* and *Martin* fails to teach or suggest all the features of Claim 1.

     1.   *The cited art fails to teach or suggest a browser performing steps in response to executing a self-contained page*

On page 3, the Office Action concedes that "Shah fails to teach a browser receiving a self-contained page; which does not have to interact over a network with a server." It is respectfully submitted that *Shah* fails to teach more than that recited in Claim 1. The Office Action then cites col. 8, lines 17-42 and col. 9, lines 10-38 of *Martin* for teaching "a browser receiving a self-contained page, and does not have to interact over a network with a server." *Martin* merely teaches that a thumbnail image of a webpage is created and stored on a computer. Subsequently, the thumbnail image may be retrieved from the computer without accessing the corresponding webpage over the Internet.

Martin only teaches that a web browser displays a web page. *Martin* does <u>not even</u> teach that web browser displays a thumbnail image (i.e., the alleged "page" of Claim 1). Even if *Martin* taught that a web browser displays a thumbnail image, *Martin* would still fail to teach or suggest that the thumbnail image is **<u>executed</u>**. Indeed, there is <u>no way</u> for a browser that is displaying a thumbnail image <u>to detect input</u> indicating the selection of one or more second criteria; <u>nor is it possible</u> for a browser displaying a thumbnail image <u>to determine</u> how a plurality of items satisfy any criteria. Instead, *Martin* teaches that a separate "self-contained viewer application" is used to view the thumbnail image (see col. 9, lines 21-38). In all, neither *Shah* nor *Martin* teach or suggest that <u>a browser performs</u> certain steps in response to <u>executing a page</u>.

Based on the foregoing, *Shah* and *Martin* fail to teach or suggest, both individually and in combination, all the features of Claim 1. Therefore, Claim 1 is patentable over *Shah* and *Martin*. Reconsideration and withdrawal of the rejection of Claim 1 under 35 U.S.C. § 103(a) is therefore respectfully requested.

        2.   *One of ordinary skill in the art would not combine* Shah *and* Martin

Regardless of whether *Shah* and *Martin* individually teach or suggest all the features of Claim 1, one of ordinary skill in the art would <u>not</u> combine *Shah* and *Martin*. After citing *Martin* for disclosing certain features of Claim 1, the Office Action asserts, "Therefore, it would have been obvious to an artisan at the time of the invention to combine the teaching of Martin with the method of Shah. <u>Motivation to do so would have been to provide a way to access elements of a page without having to go online and access the Internet, saving time and processing power</u>" (page 4; emphasis added). This is incorrect. MPEP § 2143.01(IV) requires "some objective reason to combine the teachings of the references." There is no reason to combine *Shah* and *Martin* because, other than discussing computer systems and displaying data, *Shah* and *Martin* are <u>completed unrelated to each other</u>. *Shah* teaches a method of (1) scanning a key filed of a sorted list; (2) determining sort points in the key field; (3) associating marks with the key field based on the sort-points; and (4) displaying the sorted list. In contrast, *Martin* teaches a system for: (1) generating a thumbnail image of a webpage; (2) storing the thumbnail image; (3) associating (a) the URL of the webpage and (b) the storage location of the thumbnail image on a computer with the thumbnail image; and (4) allowing a user to view the webpage or the thumbnail image upon selection of the thumbnail image.

Additionally, the alleged motivation provided in the Office Action has <u>nothing</u> to do with *Shah*. *Shah* mentions <u>nothing</u> about webpages, the Internet, or being "online." The alleged motivation comes directly from col. 8, lines 41-42 of *Martin* and, possibly, also from

page 3, lines 16-23 and page 13, lines 3-6 of Applicant's specification. If any part of the alleged motivation was gleaned only from Applicant's specification, then the judgment of obviousness is improper (see MPEP § 2145(X)(A)). Ultimately, the Office Action fails to articulate a sufficient reason why one of ordinary skill in the art would combine *Martin* with *Shah*.

Even if *Shah* and *Martin* were combinable, it is not clear how the combination would be made, what the combination would be, and what modifications to each cited reference would have to be made. As noted above, *Shah* and *Martin* are completely unrelated to each other.

B.   CLAIM 11

In rejecting independent Claim 11, the Office Action states, "Claim 11 is similar in scope to that of claim 1, and is therefore rejected under similar rationale" (page 7). Simply because Claims 1 and 11 have similar scope does not mean that Claims 1 and 11 have identical scope. In fact, Claim 11 includes **multiple features** that are absent from Claim 1, such as the steps of generating the recited first, second, third, and fourth page elements that cause or enable a browser to perform certain actions. **The Office Action fails to cite any portion of *Shah* and *Martin* for disclosing these features of Claim 11 that are not found in Claim 1**. Indeed, *Shah* and *Martin* fail to teach or suggest any of these features of Claim 11 that are not found in Claim 1.

In an Office Action "the particular part relied on must be designated as nearly as practicable ..." (37 C.F.R. § 1.104, MPEP § 707). The failure to specify any specific part of *Shah* or *Martin* that correlates to multiple elements in Claim 11 is tantamount to admitting that *Shah* and *Martin* fail to teach all the limitations of Claim 11. Reconsideration and withdrawal of the rejection of Claim 11 is therefore respectfully requested.

If the Examiner intends to issue another Office Action, then that Office Action should be **non-final** so as to enable the Applicant an opportunity to respond and, if required, amend Claim 11.

C.   CLAIMS 3-10 AND 12-13

Claims 3-10 and 12-13 are dependent claims, each of which depends (directly or indirectly) on one of the claims discussed above. Each of Claims 3-10 and 12-13 is therefore patentable over the cited art for at least the reasons given above for the claim on which it depends. In addition, each of Claims 3-10 and 12-13 introduces one or more additional limitations that may render it independently patentable. However, due to the fundamental differences already identified and to expedite the positive resolution of this case, a separate discussion of those limitations is not included at this time. The Applicant reserves the right to further point out the differences between the cited art and the novel features recited in the dependent claims.

D.   CLAIMS 27-38

Each of Claims 27-38 is a storage media claim that depends on one of the claims discussed above. Each of Claims 27-38 is therefore patentable over the cited art for at least the reasons given above for the claim on which it depends.

III.   **CONCLUSION**

For the reasons set forth above, it is respectfully submitted that all of the pending claims are now in condition for allowance. Therefore, the issuance of a formal Notice of Allowance is believed next in order, and that action is most earnestly solicited.

The Examiner is respectfully requested to contact the undersigned by telephone if it is believed that such contact would further the examination of the present application.

Please charge any shortages or credit any overages to Deposit Account No. 50-1302.

Respectfully submitted,

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